REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 16 to 22, claims 9 to 15 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending, non-withdrawn claims are allowable, and reconsideration is respectfully requested.

Applicants thank Examiner for acknowledging the claim for foreign priority and indicating that all copies of the certified copies of the priority documents have been received from the International Bureau.

II. Rejection of Claims 9, 10, 14 and 15 Under 35 U.S.C. § 102(b)

Claims 9, 10, 14 and 15 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,895,625 ("Thoma et al."). It is respectfully submitted that Thoma et al. do not anticipate these claims for at least the following reasons.

Claim 9 relates to a method for coating a substrate, including: one of (a) external currentless and (b) electrolytic deposition of at least one of (a) Ni, (b) Co and (c) Pt in a deposition bath in which particles including at least one of (a) Mg, (b) Al, (c) Ti, (d) Zn and (e) no Cr are suspended, the particles becoming occluded in the coating; and heat treating the coated substrate.

Although Applicants may not agree with the merits of the rejection, to facilitate matters, claim 9 has been amended to recite, in relevant part, that the method for coating a substrate includes one of (a) external currentless and (b) electrolytic deposition of at least one of (a) Ni, (b) Co and (c) Pt in a deposition bath in which ***particles including at least one of (a) Mg, (b) Ti and (d) Zn, and not including Cr***, are suspended, the particles becoming occluded in the coating. Support for these amendments may be found, for example, on page 3, lines 2 to 6 and page 5, lines 3 to 4 of the Specification.

Thoma et al. do not disclose, or even suggest, the above-mentioned feature. Thoma et al. do describe a method for producing a galvanically deposited, protective coating on a structural component, where the coating includes a cobalt and/or nickel matrix and embedded metal alloy particles containing chromium and/or aluminum. The cobalt and/or nickel matrix metal is part of an electrolyte, and the

chromium and/or aluminum-containing metal alloy particles are suspended in the electrolyte. However, as indicated in column 2, lines 47 to 52, column 3, lines 51 to 65, all of the disclosed examples, and claims 1 and 4 of Thoma et al., ***none of the metal alloy powders described by Thoma et al. include at least one of (a) Mg, (b) Ti and (d) Zn and do not include Cr***. Accordingly, it is respectfully submitted that Thoma et al. do not anticipate claim 9 for at least these reasons.

As for claims 10, 14 and 15, which depend from claim 9 and therefore include all of the features of claim 9, it is respectfully submitted that Thoma et al. do not anticipate these dependent claims for at least the reasons set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 11 and 13 Under 35 U.S.C. § 103(a) ("Thoma et al.")

Claims 11 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Thoma et al. It is respectfully submitted that Thoma et al. do not render these claims unpatentable for at least the following reasons.

Claims 11 and 13 depend from claim 9 and therefore include all of the features of claim 9. As set forth in detail in Section II of this response, Thoma et al. do not disclose, or even suggest, all of the features of claim 9. Accordingly, it is respectfully submitted that Thoma et al. do not render unpatentable claims 11 and 13, which depend from claim 9.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claim 12 Under 35 U.S.C. § 103(a) ("Thoma et al." and "McMordie et al.")

Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Thoma et al. and U.S. Patent No. 5,650,235 ("McMordie et al."). It is respectfully submitted that the combination of Thoma et al. and McMordie et al. does not render claim 12 unpatentable for at least the following reasons.

Claim 12 depends from claim 9 and therefore includes all of the features of claim 9. As set forth in detail in Section II of this response, Thoma et al. do not disclose, or even suggest, the feature of claim 9, that the method for coating a

substrate includes one of (a) external currentless and (b) electrolytic deposition of at least one of (a) Ni, (b) Co and (c) Pt in a deposition bath in which particles including at least one of (a) Mg, (b) Ti and (d) Zn, and not including Cr, are suspended, the particles becoming occluded in the coating. McMordie et al. do not cure the deficiencies of Thoma et al. with respect to the above feature. Furthermore, neither Thoma et al., nor McMordie et al. disclose, or even suggest, the feature of claim 12 that the deposition bath includes suspended silicon particles, the silicon particles becoming occluded in the coating. McMordie et al. do describe a process, which includes enriching the surface of an alloy substrate with platinum by, e.g., electrolytic deposition and diffusing aluminum and silicon into the platinum-enriched substrate. However, as indicated in column 6, lines 16 to 25, McMordie et al. react aluminum and silicon with the platinum-enriched substrate ***in slurry form, and not in the form of a suspension in an electrolyte solution***. In addition, Thoma et al. do describe suspending metal alloy powders in an electrolyte containing cobalt and/or nickel ions for the purpose of producing a cobalt and/or nickel layer on a substrate, where a portion of the suspended metal alloy powders become embedded in the cobalt and/or nickel layer. ***However, Thoma et al. only show the embedding of suspended metal alloy powders in a galvanic layer, and not suspended silicon. In addition, Thoma et al. give no indication of any potential success of embedding suspended silicon in a galvanic layer***. Therefore, given the disclosures of Thoma et al. and McMordie et al., one skilled in the art would not be motivated to suspend silicon in a solution for the purpose of embedding silicon in a galvanically deposited metallic layer. Accordingly, it is respectfully submitted that the combination of Thoma et al. and McMordie et al. does not render claim 12 unpatentable for at least these reasons.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Conclusion

In light of the foregoing, Applicants respectfully submit that all pending, non-withdrawn claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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